

REMARKS

Reconsideration of the above-identified application is respectfully requested.

Claims 1-5 were rejected as unpatentable over Budd in view of Chandra et al. In the statement of rejection, the Examiner gives 5,935,638 as the number of the Budd patent. Presumably 5,593,782 was intended.

The Budd patent relates to coating phosphors. The Chandra et al. patent relates to coating silicon wafers ("substrates such as electronic devices"). It is respectfully submitted that there is no basis for the proposed combination other than applicant's claims; *In re Rouffet*, 47 USPQ2d 1453, at 1457 (Fed. Cir. 1998).

Claims 1-5 relate to a process using an organotrichlorosilane compound in a fluidized bed. The Chandra et al. patent relates to chemical vapor deposition (CVD), column 7, lines 21-32, and discloses that "Precursor gases that can be used in the CVD processes include mixtures of silanes or halosilanes such as trichlorosilane in the presence of tetraethylorthosilicate, alkylsilanes such as trimethylsilane and silacyclobutane." (1) This is the only mention of trichlorosilane in the Chandra et al. patent. (2) The trichlorosilane is used in a radically different process for treating a substantially different material. (3) A mention of the existence of a chemical compound does not thereby teach every use of such a compound.

In view of the foregoing, it is respectfully submitted that the proposed combination of teachings fails to render obvious the invention recited in claims 1-5.

Claims 6 and 7 were rejected as unpatentable over Klinedinst et al. in view of Chandra et al. For the reasons given with respect to claims 1-5, the combination of any patent with the Chandra et al. patent is improper.

Claims 8-10 were rejected as unpatentable over Klinedinst et al. in view of Okuhira. In support of the rejection, the Examiner asserts that the Okuhira patent discloses (?) "as a precursor for CVD process." The Okuhira patent (6,271,333) relates to a moisture curable silicone rubber (bathtub sealant). There is no disclosure of CVD or any similar process as alleged by the Examiner.

The Okuhira patent discloses trichlorosilane, along with a host of other compounds, in connection with formula (a) in column 3. (1) It is respectfully submitted that there is no basis for the proposed combination other than applicant's claims; *In re Rouffet*, 47 USPQ2d 1453, at 1457 (Fed. Cir. 1998). (2) The mere existence of a chemical does not teach all the uses of that chemical.

The Examiner's attention is directed to the following discussion of obviousness from *Mitsubishi Electric Corp. v. Ampex Corp.*, 51 USPQ2d 1910 (Fed. Cir. 1999).

"Obviousness The trial judge correctly instructed the jury that an obviousness determination requires consideration of the following:

One, what was the scope and contents of the prior art at the time the alleged invention was conceived; what were the differences if any between the prior art at the time the alleged invention was conceived; what were the differences if any between the prior art and the alleged invention, that is, what does this alleged invention add to what was already known; and three, what was the level of ordinary skill in the prior art at the time the alleged invention was made.

In making your determination you should also consider [secondary considerations] . . .

In order to be patentable, an invention must not be obvious to a hypothetical person of ordinary skill in the art at the time the invention was made

See, e.g., *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). With respect to how to analyze a combination of prior art references, the court instructed the jury as follows:

The mere existence in the prior art of individual features of a patented invention does not without more invalidate the patent under the obviousness test. There must be evidence that the bringing together of such features or steps would have been obvious to an ordinarily skilled person. It is improper to combine prior art references solely because the inventor's patent itself suggests the new combination of old elements. Thus, to combine any of the teachings of the prior art there must be some teaching or suggestion supporting the combination.

Further, you may not combine the features of prior products where the prior art itself teaches against the combination.

We discern no flaw in these instructions."

The Examiner's attention is also directed to the enclosed prior art, discovered since receiving the above-identified Office Action. It is requested that the cited art be considered and included in the list of references cited. The Klinedinst published application discloses providing a second coating on a phosphor particle. The Yocom patent also discloses providing a second coating on a phosphor particle [column 3, lines 13-15]. Neither publication discloses treating previously coated particles with an organotrichlorosilane compound.

In view of the foregoing amendment and remarks, it is respectfully submitted that claims 1-10 are in condition for allowance and a Notice to that effect is respectfully requested.

Respectfully submitted,



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